

REMARKS/ARGUMENTS

The Office Action dated October 31, 2008 has been carefully reviewed. Reconsideration of the rejections contained therein is respectfully requested in view of the following remarks. Claims 1-4, 6-10, 12-16, 18-22 and 24-47 are pending in the application.

35 U.S.C. § 103 Rejections

Claims 1-4, 6-10, 12-16, 18-22, and 24-47 were rejected under 35 U.S.C. § 103 (a) as allegedly being unpatentable over Hall et al. (U.S. Patent No. 6,032,051) in view of Mathis (U.S. Patent Publication No. 2003/0119540) and in further view of Keating et al. (U.S. Patent Publication No. 2004/0082352). Applicant respectfully traverses this rejection for at least the following reasons.

MPEP 706.02(i) sets forth the standard for a Section 103(a) rejection:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Additionally, the "Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.*", (hereinafter "KSR Guidelines") further supports the basic requirement for a finding of obviousness as clearly articulated in the following:

To reject a claim based on this rationale, Office personnel must resolve the Graham factual inquiries. Office personnel must then articulate the following:

- (1) a finding that the prior art included each element claimed, although not necessarily in a single prior art reference, with the only difference between the

claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference;

(2) a finding that one of ordinary skill in the art could have combined the elements as claimed by known methods, and that in combination, each element merely would have performed the same function as it did separately;

(3) a finding that one of ordinary skill in the art would have recognized that the results of the combination were predictable; and

(4) whatever additional findings based on the Graham factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

The rationale to support a conclusion that the claim would have been obvious is that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded nothing more than predictable results to one of ordinary skill in the art at the time of the invention. “[I]t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.” If any of these findings cannot be made, then this rationale cannot be used to support a conclusion that the claim would have been obvious to one of ordinary skill in the art.

The 35 U.S.C. § 103(a) obviousness rejection of claims 1-4, 6-10, 12-16, 18-22, and 24-44 is improper because the elements for a *prima facie* case of obviousness are not met.

i) *The references do not teach or suggest all the features of the claimed invention*

Applicants' independent claim 1, for example, is directed to sharing user information in a wireless communication network outside of a call setup, including “*sending an alert from an originator to a group communication server (GCS), the alert including presence information about the originator and requesting presence information about a target... [and] receiving information by the originator from the GCS containing information about the target in response to the alert.*” Independent claims 7, 13, 19, 25, 30, 35, and 40 recite similar features. Applicants

respectfully reassert that Hall, Mathis, and Keating, either alone or in combination, fail to teach or suggest at least this feature of the independent claims, as detailed below.

The Examiner acknowledges that Hall does not teach a group communication server, or communications between mobiles and a group communication server, but relies on Mathis for teaching features of the claimed invention involving a group communication server.

Mathis teaches that presence information is displayed at a particular communication device that has access to a contact list, which identifies members of the group call. The presence information includes a presence status for each of the members of a group call.

The Examiner appears to be reading features into Mathis that are not disclosed. While Mathis teaches the use of contact lists with presence information for each contact, Mathis does not address the manner in which the presence information is obtained or updated. The Examiner infers that presence information is requested by the server from each client device, when Mathis is silent to this point. It could very easily be that each device in Mathis voluntarily sends the server its presence information, or an update to its presence information, for example, without being prompted by the server. The Examiner also infers that presence information is sent by the server to a device in response to an alert received from the device, when again Mathis is silent to this point. There is nothing to suggest that presence information is transmitted in an “alert” to the server that also requests presence information about a target device, nor is there anything in Mathis to suggest that the server responds to such a request with information about the target.

In sections [0012]-[0013] of Mathis relied upon by the Examiner, the only mention of actually modifying presence information is that “[i]n the preferred embodiment, the server 112 uses an efficient multicast-based distribution mechanism.” (Paragraph [0013], lines 29-30.) Again though, this merely addresses distribution of presence information updates from the server

with no details being provided about the updates themselves. There is simply no indication in Mathis that an "alert" is sent from the client to the server, that the alert includes both presence information about the client and a request for presence information about a target, or that an update is sent from the server in response to the alert as in the claimed invention.

It appears at best the Examiner is relying on inherency to provide the foregoing missing features. However, as stated in MPEP § 2112, "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). For example, as noted above, Mathis does not address the manner in which the presence information is obtained or updated. Whether or not Mathis may possibly perform some operations as alleged by the Examiner, does not provide a basis in fact that these operations necessarily are performed as alleged.

Accordingly, reconsideration and withdrawal of the foregoing rejections are respectfully requested.

ii) *There is not sufficient suggestion or motivation to combine or modify the references*

Secondly, the rejection fails to meet the *prima facie* obviousness criterion that there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the references, and that the proposed combination be tenable.

In the response to arguments section of the Final Office Action, the Examiner appears to acknowledge that Keating is in fact directed to operations within a call setup, whereas the claimed invention specifically recites sharing user information in a wireless communication network outside of a call setup. (Final Office Action at pg. 3.) However, the Examiner alleges that the teachings of Keating are applied to the teachings of Hall which are performed outside of a call setup and so the context of Keating's teachings is irrelevant. (*Id.*) Applicant disagrees because Keating relies exclusively on the process of setting up a call to initiate operation of the disclosed dispatch application processor (DAP) and query invited participants, and is therefore not capable of performing a method of sharing user information in a wireless communication network outside of a call setup.

Keating teaches that a leader sets up a group call through the DAP, which queries invited participants if they would like to join the group call. If a response is not received from a particular participant, that participant is not added to the group call at that time. As such, Keating's teachings of creating a dynamic group and determining whether a user will be added to that group would need to be modified in the proposed combination to query other devices about their status without asking whether they would like to join the call (i.e., outside of a call setup) and waiting for a response. The proposed combination therefore at least changes the principle of operation behind the teachings of Keating whereby potential participants are queried through the

call setup procedure itself. It is a well known tenet of U.S. patent law that if the proposed modification of a reference would change the principle of operation of the reference's invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. See In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). See also MPEP § 2143.01. See also the KSR Guidelines, referenced above, requiring that "each element merely would have performed the same function as it did separately."

Alternatively, Hall could be made to query client devices in the process of setting up a call, thereby avoiding modification of the principle of operation of Keating, but such a combination would inherently teach away from the claimed invention. It is also a well known tenet of U.S. patent law that it is improper to combine a reference in a 35 U.S.C. § 103(a) obviousness rejection where the reference teaches away from the claimed invention. See W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). See also MPEP § 2141.02.

Accordingly, the proposed combination of Hall and Keating is untenable for alternately changing the principle of operation of Keating and/or teaching away from the claimed invention.

For at least the foregoing reasons, it is respectfully submitted that claims 1, 7, 13, 19, 25, 30, 35, and 40 are distinguishable over the applied art. The remaining dependent claims are allowable at least by virtue of their dependency on the above-identified independent claims. See MPEP § 2143.01. Moreover, these claims recite additional subject matter, which is not suggested by the documents taken either alone or in combination. For example, claim 45 recites "wherein transmitting the alert from the GCS to the target occurs before sending the alert from the originator to the GCS." In the rejection of claim 45, the Examiner alleges that Mathis teaches that "the server can request presence information from the devices thus causing said devices to

send presence information.” (Final Office Action at pg. 20). Again, however, the Examiner is inferring these teachings without actual support in Mathis, which makes no mention of the manner in which presence information from a particular client device is updated. Claim 47 recites “wherein the information received by the originator from the GCS includes an indication of which members in a given group are participating in a group communication session.” In the rejection of claim 47, the Examiner alleges that Mathis teaches indicating whether a client device is busy and that “client device busy with other operations renders a myriad of scenarios such as participating in a group communication session.” (Final Office Action at pg. 21). Again, however, the Examiner has no basis for this interpretation. The fact that a client could be “busy” because he is engaged in a group communication is wholly speculative; a “busy” indication may in fact mean the opposite, that the device is unable or unwilling to participate in group communication sessions. Even so, a generic “busy” indication does not convey that members in a given group are specifically participating in a group communication session like in the claimed invention (as the Examiner notes, there are “a myriad of scenarios” leading to a busy indication).

Accordingly, reconsideration and withdrawal of the foregoing rejections are respectfully requested.

CONCLUSION

In view of the foregoing amendments and remarks, it is respectfully submitted that the application is in condition for allowance. If the Examiner believes that any additional changes would place the application in better condition for allowance, the Examiner is invited to contact the undersigned attorney, at the telephone number listed below.

Deposit Account Authorization

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any fees or overpayments that may be due with this response to Deposit Account No. 17-0026.

Respectfully submitted,

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By: 

Raphael Freiwirth
Reg. No. 52918

QUALCOMM Incorporated
Attn: Patent Department
5775 Morehouse Drive
San Diego, California 92121-1714
Telephone: (858) 658-5787
Facsimile: (858) 658-2502

Attachment(s): (none)